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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,496	03/15/2005	Georg Ignatius	IGNATIUS	4527
20151 7590 06/03/2010 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER PIERCE, WILLIAM M				
ART UNIT		PAPER NUMBER		
3711				
NOTIFICATION DATE		DELIVERY MODE		
06/03/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

Office Action Summary

Application No.

10/500,496

Applicant(s)

IGNATIUS, GEORG

Examiner

William M. Pierce

Art Unit

3711

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/2/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) 40, 41, 44, 45 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35, 37-39, 42, 43 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 43 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 43, "the actuating element" lacks a clear and consistent antecedent.

Claim Rejections - 35 USC § 102

Claims 35, 37-39, 42, 43 and 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright as set forth below.

As to claims 35, 38, 42 and 48, Wright shows a handle part 34, impact part 30 and actuating part 20 with a plurality of singular active elements 306, 302, 308, 310, 304, 312 and 314 formed over less than the length of the actuating part at predefined uniformly spaced locations defined by two or more harmonic series, as shown in fig. 8 and first and second modes of vibration at col. 4, lns. 16 and 17, that are differing from their respective surroundings by being different material col. 9, ln. 56+. As to claim 37, element 302 is considered more massive than 308. Claim 39 is met by fig. 5. As to claim 43, paints having granulated materials, such as metal flakes, are known. To have added a layer to the elements of Wright would have been obvious in order to decorate or provide a more finished appearance. Claim 46 is considered shown at col. 5, ln. 29. To have applied the teachings of Wright to other sporting equipment such as a hockey stick or baseball bat as called for in claims 47 and 49 would have been obvious in order to dampen vibrations therein.

Claims 35-39, 42, 43, 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Monette 5,683,308 as set forth in the previous office action;

"As to claim 35, 37-39, 42 and 48, active elements 40 are considered to be arranged between a first end and second end uniformly spaces where 42 is considered to be the adjacent end. As to claim 36, a second harmonic series is considered show by active elements 40 as called for by claim 36. Claim 43 is considered inherent in Monette where the disks 40 are made of rubber (col, 3, ln. 19) which can be granular. See 4,031,302 by way of example.

As to claim 46, the selection of a material to take advantage of its known properties has been held to be obvious. To have replace the rubber in the discs 40 and 42 of Monette would have been obvious to modify the vibrational response of the shaft. Applicant has not shown where the selection of metal solved any particular problem or produces any unexpected results."

Claim Rejections - 35 USC § 103

Claims 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monette in view of Yamaguchi 4,928,965 as set forth in the previous office action;

"The applications of vibration modification techniques from one type of sport device to another is well known. See Yamaguchi 4,928,965 who teaches that such designing techniques can be used on a bat, club, racket or paddle for an example."

Conclusion

Applicant's arguments filed 3/2/10 have been fully considered but they are not persuasive.

Applicant argues that Monette cannot show a harmonic series "due to the handle which is made thicker than the body." However, applicants own figs. 5 and 6 too show a handle thicker than the body. As such applicant's argument is not persuasive since if Monette did not inherently produce harmonic vibrations by applicant's reasoning neither would the invention as disclosed. Applicant's subsequent argument that the impacting

instruments must have significant asymmetries does little since the shape of the instrument and asymmetry is not part of the claimed invention.

Applicant criticizes Monette by stating that the placement of his discs would be difficult "due to the fact that both the handle position (grip) and the location of the impact on the surface of the impacting instrument are somewhat different with each impact. This argument would hold true for applicant's invention where a different grip and the contact of an object would be different with each impact making the placement of the active elements according to a strict harmonic series difficult. As such this argument is not persuasive.

Applicant argues that his combination of claim 36 with 35 amounts to the spacing of his elements. However, claim 36 does nothing to call for uniform spacing. It merely calls for the spacing be "defined by two or more harmonic series". Monette is concerned with attenuating "certain frequencies of vibration" (col. 1, ln. 66) and to deal with these vibrations and to enhance the feel of the club. Since it is inherent that many modes of vibration exist in Monette and that the spacing of his disc intend to minimize their effects, the spacing of his discs are considered to be defined by the vibrations along the length of his club and the non uniform spacing of his discs are meant to cancel out more than one harmonic series.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email, such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the

appropriate patent application. The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711